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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,927	03/18/2004	Toshihisa Nakano	2004_0442A	5415
513 7590 08/28/2008 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021				
EXAMINER GEE, JASON KAI YIN				
ART UNIT 2134		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/802,927

**Applicant(s)**

NAKANO ET AL.

**Examiner**

JASON K. GEE

**Art Unit**

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 July 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.  
4a) Of the above claim(s) 17-22 and 24 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-16, 23, 25, and 26 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date 6/10, 10/27, 01/04, 5/08, 08/07  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_



***DETAILED ACTION***

1. This action is response to communication: response to election/restriction received 07/15/2008, with acknowledgement of priority date of 03/24/2003.
2. Claims 1-26 are currently pending in this application.
3. The applicants have elected without traverse Group 1 (claims 1-16, 23, 25, and 26). Claims 17-22 and 24 have been withdrawn.
4. The IDS received 06/10/2004, 10/27/2004, 01/04/2008, 05/08/2008, and 08/07/2008 has been accepted.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 2 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As per claim 2, the claim recites wherein the content ID unit identifies, as the type of the content, at least one of a first type in which the content is provided through a transmission medium and a second type in which the content is provided by the recording medium. These types, as claimed in independent claim 1, are used in a

decision making process to record a content onto a recording medium. It is not clear how the system would operate, as the claims are reciting that the content provided by the recording medium is being used to create the content on the recording medium.

As per claim 11, the claim recites wherein the recording unit records a second content by a second recording method on the recording medium while retaining a first content. It is unclear in the specification how content on a medium may be recorded on the same medium as the first medium, wherein the first content information on the same medium is retained and not erased.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 14-16, claim 14 recites wherein the content obtainment unit encrypts the content according to a recording method adopted by a recording unit that is a destination of the transmission and sends the encrypted content to the recording unit. It is unclear which recording unit this is referring to, as there seem to be two recording units claimed.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 25 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 25, the claim recites a recording medium. However, the specification indicates that a recording medium may be a transmission medium, such as in paragraphs 25 and claim 2 of the Applicants specification. Mediums such as transmission mediums are directed toward non-statutory subject matter.

As per claim 26, the claim recites a computer program. Claims directed toward a program are non-statutory subject matter and are therefore rejected under 101.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-4, 23, 25, and 26 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by the Applicants Admitted Prior Art (hereinafter the AAPA), as presented by the applicants Patent Application Publication No. 2004/0190868. .

As per claim 1, the AAPA teaches a recording apparatus for recording a content which is a digital copyrighted work onto a recording medium, comprising: a content obtainment unit operable to obtain a content provided externally (paragraph 13); a content type identification unit operable to identify a type of the obtained content (paragraph 13); a recording medium type identification unit operable to identify a type of the recording medium (paragraph 13); a recording method selection unit operable to select at least one recording method out of a plurality of recording methods based on the type of the content identified by the content type identification unit and the type of the recording medium identified by the recording medium type identification unit (paragraphs 13-15); and a recording unit operable to record the content onto the recording medium according to the selected recording method (paragraphs 14-16).

Claim 2, as best understood by the Examiner, is rejected using the AAPA in paragraphs 13-15.

As per claim 3, the AAPA teaches wherein the recording medium type identification unit identifies the type of the recording medium according to a type of information previously stored in a non-rewritable area of the recording medium (paragraphs 5 and 10 -15).

As per claim 4, the AAPA teaches wherein the recording method selection unit selects said one recording method out of the plurality of recording methods compliant with a method for protecting a copyright of a content (paragraphs 13-15 and paragraphs 3, 4, and 10).

Independent claim 23 is rejected using the same basis of arguments used to reject claim 1 above.

Independent claim 25 is rejected using the same basis of arguments used to reject claim 1 above.

Independent claim 26 is rejected using the same basis of arguments used to reject claim 1 above.

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 5-7 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the AAPA as applied above, and in view of Sako et al. US Patent Application Publication 2003/0012098 (hereinafter Sako)

As per claim 5, the AAPA does not explicitly teach all the limitations of these claims. However, these are taught throughout by Sako. Sako teaches wherein the



recording method selection unit further selects said one recording method out of the plurality of recording methods based on an instruction from a provider of the content, such as in paragraph 97 and throughout the reference.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the Sako reference with the AAPA. One of ordinary skill in the art would have been motivated to perform such an addition to provide a record medium, a recording method for a record medium, an output controlling method, a reproducing apparatus, a record and reproduction controlling method, a recording method, a recording and reproducing method, and a recording and/or reproducing method that allow a copy operation in a plurality of generations, a reproducing operation, and a charging operation to be easily managed. (Sako paragraph 10).

As per claim 6, Sako teaches wherein the content includes specification information for specifying said one recording method out of the plurality of recording methods (paragraph 97); and the recording method selection unit further selects said one recording method out of the plurality of recording methods based on the specification information included in the content (paragraphs 97, 100, Figure 3).

As per claim 7, Sako teaches wherein the recording method selection unit further selects said one recording method out of the plurality of recording methods based on an instruction by a user (paragraph 159).

As per claim 10, Sako teaches wherein the content obtainment unit includes a plurality of input channel units, each corresponding to a type of data to be obtained, and

the recording method selection unit further selects said one recording method out of the plurality of recording methods and recording to which one of the plurality of the input channel units has obtained the content (paragraphs 57, 58, 83, 84, 85, 91, 92, and AAPA paragraph 13).

As per claim 11, Sako teaches wherein the recording unit records a second content by a second recording method on the recording medium while retaining a first content, when the first content is recorded on the recording medium by a first recording method (Figures 3, 7, paragraphs 109-116, and throughout the reference).

As per claim 12, Sako teaches wherein a first content is recorded onto the recording medium by a first recording method, and the recording apparatus further records the first content by a second recording method onto the recording medium after reading out the first content from the recording medium (paragraphs 109-118).

As per claim 13, Sako teaches wherein the recording method selection unit selects two or more recording methods out of the plurality of recording methods and the recording unit records the content onto the recording medium according to the selected two or more recording methods (paragraphs 197-198 and throughout reference; also AAPA paragraphs 13-16).

15. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the AAPA as applied above, and in view of Strom et al. US Patent Application Publication 2004/0003274 (hereinafter Strom)

As per claim 8, the AAPA does not explicitly teach all the limitations of the claims. However, these are taught by Strom. Strom teaches wherein the recording method selection unit further selects said one recording method out of the plurality of recording methods based on a security level required for the content (paragraphs 61, 63, 70, 78, and throughout reference).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the AAPA and Strom references. One of ordinary skill in the art would have been motivated to perform such an addition to increase flexibility in security to prevent unfettered distribution of copy-protected content, while allowing copying of content to a specific computing device (paragraphs 5 and 6 of Strom).

16. Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the AAPA as applied above, and in view of Nagai et al. US patent Application Publication 2002/0015494 (hereinafter Nagai)

As per claim 9, the AAPA does not explicitly teach all the limitations of the claims. However, these are taught by Nagai, such as in paragraphs 71-75, wherein the recording method selection unit further selects said one recording method out of the plurality of recording methods based on quality of the content.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the teachings of Nagai with the AAPA. One of ordinary skill in the art

would have been motivated to perform such an addition to increase the security while maintaining low costs (paragraphs 18 and 19 of Nagai).

As per claim 12, Nakai teaches wherein a first content is recorded onto the recording medium by a first recording method, and the recording apparatus further records the first content by a second recording method onto the recording medium after reading out the first content from the recording medium (throughout the reference; also shown in Figures 2A and 2B).

17. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the AAPA as applied above, and in view of Andreaux et al. US Patent Application Publication 2003/0051153 (hereinafter Andreaux)

As per claim 14, the AAPA does not explicitly teach all the limitations of the claims. However, these are taught throughout Andreaux. Andreaux teaches wherein the content obtainment unit sends the obtained content to the recording unit via a transmission channel, the recording unit records the content received via the transmission channel onto the recording medium, and the content obtainment unit encrypts the content according to a recording method adopted by a recording unit that is a destination of the transmission and sends the encrypted content to the recording unit (throughout the reference, such as in the abstract, paragraphs 15-19, 53-54).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the AAPA and the Andreaux references. One of ordinary skill in the art would have been motivated to perform such an addition to increase the flexibility to add encryption accordingly and would also increase the security as well (paragraph 31 of Andreaux).

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the AAPA and Andreaux as applied above, and further in view of Nagai.

As per claim 15, Andreaux teaches wherein the recording method includes a first recording method and a second recording method compliant with the method for protecting a copyright of a content (paragraphs 73-86 and also AAPA paragraph 13). Andreaux further teaches wherein the content obtainment unit encrypts the content with a previously held secret key when the recording unit adopts the first recording method (paragraphs 78 and 86). Nagai further teaches wherein an encryption is made with an externally obtained secret key when the recording unit adopts the second recording method (paragraphs 63-65).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the teachings of Nagai with the AAPA combination. One of ordinary skill in the art would have been motivated to perform such an addition to increase the security while maintaining low costs (paragraphs 18 and 19 of Nagai).

As per claim 16, Andreaux teaches wherein the recording method includes a first recording method and a second recording method compliant with the method for

protecting a copyright of a content (paragraphs 73-86 and also AAPA paragraph 13). Nagai further teaches wherein the content obtainment unit reencrypts the content into an encrypted content corresponding to the second recording method and sends the reencrypted content to the recording unit when the obtained content is an encrypted content corresponding to the first recording method (paragraphs 62-65).

### ***Conclusion***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason K. Gee whose telephone number is (571) 272-6431. The examiner can normally be reached on M-F, 7:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571) 272-3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Patent Examiner  
Technology Center 2100  
08/25/2008

Primary Examiner, Art Unit 2134